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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of

Group 1643

Madhwa H.G. Raj *et al.*

Examiner Duffy, Bradley

Serial No. 10/797,690

Filing Date: March 10, 2004

For: Treatment of Prostate Cancer (File Raj 02M27.1)

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This paper is submitted in response to the July 11, 2006 restriction requirement.

No amendments are presented.

Enclosed is a check for \$225 for a two-month extension of time, to extend the time for response from August 11, 2006 to October 11, 2006, paid as a small entity. If this amount is incorrect, please refer to the Deposit Account Authorization previously filed for this application. If any additional extension of time is required, please consider this paper a petition for the total extension of time required. See 37 C.F.R. § 1.136(a)(3).

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**CERTIFICATE**

I hereby certify that this Response to Restriction Requirement, and the enclosed check for \$225 are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 9, 2006.

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John H. Runnels

Registration No. 33,451

October 9, 2006

Applicants respectfully traverse the restriction requirement, for the reasons given below.

### **Provisional Election**

In response to the restriction requirement, Applicants provisionally elect with traverse Group VII, which the Office identified as including Claims 9, 10, 13, 14, 22, and 23.

### **Traversal of Restriction Requirement :**

#### **The Office Has Not Established the Distinctness of any of the Groups.**

The Office has not carried its burden of showing that any of the 12 Groups are distinct from one another.

In order to properly justify a proposed twelve-way restriction requirement, the Office would need to demonstrate that each pair of Groups is distinct from one another: The Office has the burden of showing each of the following:

that Group I is distinct from Group II,  
that Group I is distinct from Group III,  
that Group I is distinct from Group IV,  
...  
that Group I is distinct from Group XII,  
that Group II is distinct from Group III,  
that Group II is distinct from Group IV,  
...  
that Group II is distinct from Group XII,  
that Group III is distinct from Group IV,  
...  
that Group VI is distinct from Group X,  
... and  
that Group XI is distinct from Group XII.

The Office would thus need to provide a total of  $11 + 10 + 9 + 8 + \dots + 3 + 2 + 1 = 66$  demonstrations of distinctness between pairs of Groups in order to justify a twelve-way restriction requirement.

However, the Office has in fact made no demonstrations of distinctness at all. The Office has not justified restriction for even one pair of Groups, much less for all 66 possible pairings of twelve Groups.

Pages 4-6 of the July 11, 2006 Restriction Requirement discuss various ways in which the twelve Groups were found to differ from one another. Without necessarily agreeing with everything said there, the Applicants can certainly agree with the general observation that the scope of any two claims in a patent application will, in general, differ. This observation should not be the least bit surprising. Indeed, the doctrine of “claim differentiation” is based on the premise that a patent applicant will normally write each claim so that it has a scope that differs, to some degree, from the scope of every other claim presented in the application.

Simply observing that some claims have a different scope from other claims does not justify restriction. Yet, that is basically what the July 11, 2006 Office Action did. The Office Action made no attempt to explain whether, or how any of the observed differences were related to any of the standards set forth in Chapter 800 of the M.P.E.P. concerning distinctness.

In order to justify restriction, the Office would have the burden of showing, not just that different claims had differing scope, but instead that the several groups of claims were “distinct” within the contemplation of Chapter 800 of the M.P.E.P. With all respect, the July 11, 2006 Restriction Requirement does not even purport to make such a showing. No section or subsection of Chapter 800 of the M.P.E.P. was cited – even once – anywhere in the Restriction Requirement.

It does not suffice to observe that differences exist between the claims. The Office instead carries the higher burden of demonstrating that different groups of claims are “distinct” from one another, within the contemplation of specific sections of Chapter 800 of the M.P.E.P. The Office has not done so. The restriction requirement should be withdrawn accordingly.

**In the Alternative, the Office Might Consider Treating Some  
of the Proposed Restriction Requirements as  
Election of Species Requirements Instead.**

For the reasons given above, it is respectfully submitted that all restriction requirements should now be withdrawn.

Strictly in the alternative, should the Office repeat any of the restriction requirements, then it is respectfully submitted that the Office might wish to consider treating at least some of the proposed restriction requirements as election of species requirements instead (with suitable modifications).

The manner in which the Office has grouped the Claims demonstrates that restriction is improper, even without a detailed analysis of the substance of the Claims. At best, many of the proposed groupings might instead provide a foundation for an election of species requirement, but not a restriction requirement. (Of course, an election of species requirement is worded differently, and would require suitable modification.)

Even without examining the substance of the Claims, even without examining the classifications that were proposed for the Claims, and even without analyzing the proffered justifications for restriction – and instead considering only the proposed groupings of the numbered Claims and the relationships among the independent and dependent Claims – it becomes clear that the most of the proposed groupings are not proper for restriction purposes. Instead, at most they might support an election of species requirement (with suitable modification).

As an example, Claim 1 is independent. Claims 2-8 depend from Claim 1. Thus Claim 1 is generic, while Claims 2-8 are specific.

Specific claims may not ordinarily be restricted from the corresponding generic claim. If a proper justification were supplied (and to date one has not been), then an election of species requirement might perhaps be in order instead. The initially-elected species and the generic claim would then be searched and examined. If no grounds were found to reject claims drawn to the elected species, then a reasonable number of other species within the generic claim should also be examined. See M.P.E.P. § 806.04 and 37 C.F.R. § 1.146.

The July 11, 2006 Restriction Requirement would divide independent Claim 1 into six different groups. But restriction may not ordinarily be required within a single claim. See M.P.E.P. § 806.04(d); see also M.P.E.P. § 803.02.

The rationale may be illustrated by assuming, hypothetically, that the application had been filed with a single Claim: Claim 1 only. Assume that no other Claims had been presented, just Claim 1. Would the Office then have entered a six-way restriction requirement, as follows?

“Restriction to one of the following inventions is required: Group I contains Claim 1. Group II contains Claim 1. Group III contains Claim 1. Group IV contains Claim 1. Group V contains Claim 1. Group VI contains Claim 1.”

In effect, this is what the July 11, 2006 Restriction Requirement did. The presence of dependent Claims 2-8 does not change the conclusion that it is improper to restrict Claim 1 against itself.

Thus, even without considering the substance of the Claims, if one considers only the grouping of the numbered claims, and their dependencies upon one another, it is clearly improper to restrict Claims 1-8 from one another. For this reason alone, Claims 1-8 should be rejoined in a single Group.

For essentially the same reason, at least Claims 9-16 should be rejoined.

And at least Claims 17-21 should be rejoined.

Applicants repeat that these arguments are presented in the alternative, and that for the reasons previously given all restriction requirements should be withdrawn.

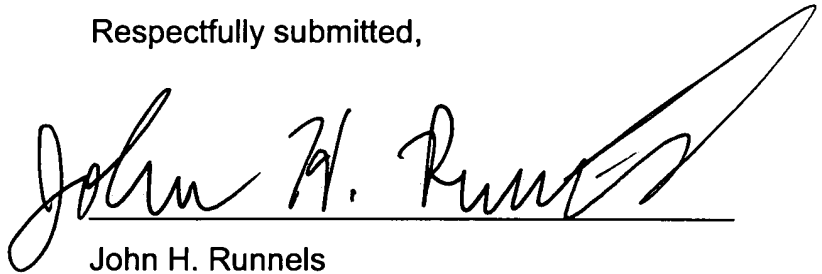
### **Conclusion**

The restriction requirement should be withdrawn in its entirety, and all Claims should be examined on their merits. In the alternative, the Claims should be re-grouped so that no Claim is restricted against itself.

The Examiner is respectfully advised that if the restriction requirement should be repeated, then it is the Applicants' present intention to file a formal Petition to review the propriety of the restriction requirement.

Allowance of Claims 1-23 at an early date is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "John H. Runnels", is written over a horizontal line. The signature is stylized with a large, sweeping initial 'J' and a long, thin tail on the 'S'.

John H. Runnels  
Registration No. 33,451  
Taylor, Porter, Brooks & Phillips, L.L.P.  
P.O. Box 2471  
Baton Rouge, Louisiana 70821  
(225) 387-3221

October 9, 2006